

Amendment and Response

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Serial No.: 09/885,395

Confirmation No.: 3952

Filed: 20 June 2001

For: LABEL FOR AFFIXING TO A GARMENT

Remarks

The Office Action mailed 16 March 2004 has been received and reviewed. Claims 1-12 having been cancelled, and claims 19-30 having been added, claims 19-30 are pending. Reconsideration and withdrawal of the rejections are respectfully requested.

The 35 U.S.C. §103 Rejection

The Examiner rejected claims 1-2, 4, and 6-7 under 35 U.S.C. §103 as being unpatentable over Stahl (U.S. Patent No. 6,194,044) in view of Silver et al. (U.S. Patent No 5,118,750). Claims 1-2, 4, and 6-7 have been cancelled. However, to the extent the rejection applies to new claims 19-20, 22, and 24-25, Applicants respectfully traverse this rejection.

"[T]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." M.P.E.P. § 2143.

The present claims recite "a second adhesive layer other than a hot melt adhesive layer, comprising an elastomeric microsphere adhesive" (e.g., present application, claims 19 and 26). The Examiner asserted that Stahl teaches "a second adhesive layer other than a hot melt adhesive layer" (page 2, lines 14-15, of the Office Action mailed March 16, 2004). Applicants respectfully disagree.

Stahl discloses the use of "a thermoplastic adhesive 14 coating one face of the fabric layer 12; a pressure-sensitive adhesive 16 coating the thermoplastic adhesive 14," but is silent regarding whether the second layer is also a hot melt adhesive (e.g., column 3, lines 1-3). Thus, Stahl fails to specifically disclose or suggest a second layer other than a hot melt adhesive. Moreover, Stahl describes the "outer adhesive being a pressure and *heat* sensitive adhesive" (e.g.,

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column 4, lines 60-61 and column 5, lines 13-14, emphasis added). Thus, Applicants respectfully submit that Stahl teaches away from the presently claimed invention.

Silver et al. disclose "solid polymeric, acrylate, infusible, inherently tacky, elastomeric, solvent dispersible, solvent-insoluble microspheres" (e.g., column 1, lines 9-13).

Applicants respectfully submit that there is no suggestion or motivation, either in the documents or in the knowledge generally available to one of ordinary skill in the art, to combine Stahl in view of Silver et al. Stahl discloses a preference for the "outer adhesive being a pressure and heat sensitive adhesive" (e.g., column 4, lines 60-61 and column 5, lines 13-14, emphasis added). In contrast, Silver et al. disclose solvent insoluble microspheres that are infusible (i.e., non-heat sensitive). Moreover, labels as claimed in the present invention can offer properties including, for example, increased repositionability and increased durability. For example, as shown in Table 1 of the present application, Comparative Example C2 with a solvent borne PSA at a dry thickness of twenty microns passed the twenty minute removability test, failed the three day removability test, and failed the durability on washing test. In contrast, Example 4 with a solvent-dispersed microsphere type PSA at a dry thickness of twenty microns passed the twenty minute repositionability test, passed the three-day repositionability test, and passed the durability on washing test.

Thus, based upon the remarks herein above, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness of claims 19-20, 22, and 24-25 under 35 U.S.C. §103. Applicants respectfully request reconsideration and withdrawal of the rejection.

The Examiner rejected claims 3, 5, and 8-12 under 35 U.S.C. §103(a) as being unpatentable over Stahl (U.S. Patent No. 6,194,044) in view of Silver et al. (U.S. Patent No. 5,118,750), and further in view of Bingham (U.S. Patent No. 3,758,192). Claims 3, 5, and 8-12 have been cancelled. However, to the extent the rejection applies to new claims 21, 23, and 26-30, Applicants respectfully traverse this rejection.

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Bingham discloses "colored reflex-reflecting structures, particularly reflex-reflecting signs, fabrics and transfer films, in which a monolayer of small transparent glass beads or microspheres is embedded in a binder layer having a reflective nacreous pigment embedded therein" (e.g., column 1, lines 7-12). Based upon the remarks herein above, Applicants respectfully submits that Bingham fails to correct the deficiencies of Stahl in view of Silver et al. noted herein above.

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness of claims 21, 23, and 26-30 under 35 U.S.C. §103. Applicants respectfully request reconsideration and withdrawal of the rejection.

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Summary

It is respectfully submitted that the pending claims 19-30 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
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August 13, 2004
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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 13th day of August, 2004, at 11:03 a.m. (Central Time).

By: [Signature]
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